

REMARKS

This communication responds to the Office Action mailed on June 20, 2005. Claims 1, 5, 7-9, 16, 20, and 24-25 are amended, claims 3, 6, and 17 are canceled, and no claims are added. It is respectfully noted that claims 5, 7-9, and 24 have been amended to correct typographical errors, as well as to maintain a consistent antecedent basis, and not for reasons related to patentability. As a result, claims 1-2, 4-5, 7-16, and 18-27 are now pending in this Application.

§102 Rejection of the Claims

Claims 1-5, 8-14, 16, 20, 22, 24 and 25 were rejected under 35 USC § 102(e) as being anticipated by Obradovich et al. (U.S. 6,542,812, Provisional Application Serial No. 60/160,326 filed on October 19, 1999; hereinafter "Obradovich"). The Applicant does not admit that Obradovich is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Applicant asserts that the Office has not shown that Obradovich discloses the identical invention as claimed, the Applicant respectfully traverses this rejection of the claims.

Claim 1, as amended, includes the limitation "wherein an application is downloaded to the memory when the first and second service preferences are determined to be related by the comparator module." Claim 16, as amended, includes the limitation "wherein the application is downloaded to the mobile element when the second service preference is determined by the processor to be related to a first service preference stored in the mobile element". Claims 20 and 25, as amended, include the limitation "wherein the application is downloaded to the mobile element upon the mobile element determining that the first service preference is related to a second service preference". As noted in the Office Action, "Obradovich ... does not explicitly teach ... downloading application to the memory for execution by a mobile element." Office Action, pg. 5, lines 1-2.

With respect to claim 13, while it is asserted in the Office Action that the hand-held unit of Obradovich includes "a comparator module (reads on processor 3) communicatively coupled to the memory to compare the first and second service preferences," a careful reading of the reference reveals this to be incorrect. Actually, "upon receiving the request from ... [the hand-

held element] server 630 determines the user's personal favorites as requested ... within a limited navigation coverage." Obradovich, Col. 8, lines 30-34. Thus, Obradovich does not teach or suggest a mobile element including "a comparator module communicatively coupled to the memory to compare the first and second service preferences," as claimed by the Applicant in claim 13.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). In fact, "[t]he *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added). Since Obradovich does not teach all of the limitations of independent claims 1, 13, 16, 20, and 25 (as well as those claims depending from them), as described above, what is disclosed by Obradovich is not identical to the subject matter of the embodiments claimed, and the rejection of claims 1-5, 8-14, 16, 20, 22, 24 and 25 under § 102 is improper. Reconsideration and allowance are respectfully requested.

§103 Rejection of the Claims

Claims 6, 7, 15, 17 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila et al. (U.S. 6,549,625; hereinafter "Rautila"). Claims 18, 19, 23 and 27 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Masaki (EP 0883270 A1; hereinafter "Masaki"). First, the Applicant does not admit that Obradovich, Rautila, or Masaki are prior art, and reserves the right to swear behind these

references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In*

re Sang Su Lee, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because either (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, or (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: First, with respect to independent claims 1, 13, 16, 20, and 25, no combination suggested in the Office Action will render all of the claim limitations. Obradovich does not disclose “a comparator module” included in the mobile element (claims 1 and 13), or downloading an application “when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element” (claim 16), or “upon the mobile element determining that the first service preference is related to the second service preference” (claims 20, 25) as claimed by the Applicant. Neither does Rautila or Masaki.

As noted above, Obradovich makes use of a server to match user preferences to broadcast services. Obradovich, Col. 8, lines 30-34. Rautila relies on the user, rather than the mobile element, to determine which preferences will be selected. See Rautila, Col. 9, lines 34-43. Masaki does not match user preferences. Thus, independent claims 1, 13, 16, 20, and 25 are nonobvious. This conclusion applies with even greater force respecting dependent claims 7, 15, 18-19, 23, and 26-27 since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

No Motivation to Combine References: The Office asserts that it would be obvious to combine Obradovich with Rautila because “this arrangement would provide ... application programs for the user to obtain information from servers.” However, this assertion is incorrect. Obradovich operates by sending user location GPS data to the server in order to provide the user with a useful route map. See Obradovich, Col. 8, lines 30-45. However, Rautila teaches away from using such data, since “not all mobile terminals will have GPS functionality” and “the position transceiver overcomes the location problem of the prior art by indicating and transmitting its own very exact predefined position.” Rautila, Col. 1, lines 39-47 and Col. 2,

lines 24-27. Using the position position transceiver location of Rautila would not provide a useful route map to the user of Obradovich. Thus, there is no motivation to combine Obradovich with Rautila.

Similarly, although the Office suggests that it would be obvious to combine Obradovich and Masaki, since “the arrangement would facilitate data transmission based on capability of the communication terminals,” this assertion is also incorrect. Obradovich teaches determining “favorite personal facilities and events, within a limited navigation coverage, e.g., defined by a predetermined radius from the GPS coordinates identified by the GPS data”, while Masaki maintains that a “user need not be aware of a location of a program or data.” Obradovich, Col. 8, lines 33-36 and Masaki, Col. 1, lines 28-29. Such awareness is at the heart of Obradovich. Thus, there is no motivation to combine Obradovich and Masaki.

The use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

No Reasonable Expectation of Success: Modifying Obradovich to implement the application download capability of Rautila will not provide a mobile element capable of determining the existence of related preferences. Neither will combining Obradovich and Masaki. Further, both combinations are at odds with determining the location of the mobile element, since Rautila disclaims this process, as does Masaki.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Therefore, since there is no evidence in the record to support the disclosure by any combination of Obradovich, Rautila, or Masaki of a mobile element that determines related preferences, and can download applications based on the comparison, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 13, 16, and 20, and 25, or any of the claims that depend from them. It is therefore respectfully requested that the rejections of claims 6-7, 15, 17-19, 23 and 26-27 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney Mark Muller at 210-308-5677, or the undersigned (at 612-349-9592), to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Aug. 22, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of August 2005.

John D. Gustaf-Wrathall

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